

Remarks

Claims 1 and 13 have been amended and claim 21 has been cancelled. Review and reconsideration of the amendments are respectfully requested.

By way of brief recap of the invention, the present invention is directed to a notebook 10 of bound sheets 14. The sheets 14 may be lined and used, for example, as shopping lists. A pouch cover 12 is located on the sheets 14 and bound thereto by the binding mechanism 18. In the embodiment specified in claim 1, the pouch 12 has generally the same size and shape in top view as the stack of papers 14, and has a mouth 38 which faces outwardly so that the mouth 38 can be accessed when the notebook is in the closed position. In the embodiment specified in claim 28, the pouch cover 12 is generally transparent so that a top one of the stack of papers 14 is visible through the pouch cover 12 when no objects are received in the pouch cover 12.

In the final Office action, claim 42 is indicated to be allowed and claims 1-3, 5-8, 11, 12, 43 and 44 are indicated to include allowable subject matter. Claim 1 remains objected-to. Accordingly, claim 1 has been amended (at lines 12-13) to change "a having a size and shape" to "having a size and shape" as requested in the Office action. Thus it is submitted that claim 1 is now allowable.

Although independent claims 1 and 42 are indicated to include allowable subject matter, the remaining independent claims (claims 13 and 28) are rejected as being anticipated by U.S. Pat. No. 5,042,841 to Friedman. Accordingly, claim 13 has been amended to include the subject matter of claim 21, and claim 21 has been canceled. Thus claim 13 now specifies that the pouch is generally transparent.

Thus, the rejection of claim 28 and (old) claim 21 and (new) claim 13 are respectfully traversed for the reasons outlined below. In taking the position that the subject matter of claim 21 is shown in the Friedman reference, the Office action refers to column 3, lines 31-33 of the Friedman reference. This passage of the Friedman reference indicates that the pouch of that reference can be made from a variety of materials such as heavy bond paper, drafting board, inexpensive plastic sheet material and the like. The Office action takes the position that the disclosure of the Friedman reference "inherently" includes a transparent material.

However, the rejection on this basis is strongly traversed. The heavy bond paper, drafting board, and inexpensive plastic sheets of the Friedman reference are nowhere described

as being transparent. This passage of the Friedman reference only discloses a listing of materials, but does not address the properties of these listed materials. Nowhere in the Friedman reference can any suggestion, teaching or even passing reference to a "transparent" material be found. Thus the Friedman reference does not include any disclosure to support the position advanced in the Office action.

The Office action appears to be making a rejection based upon an alleged "inherent" disclosure of the Friedman references. For example, in the rejection of claim 21 (at the top of page 4 of the final Office action) it is indicated that "*Inherently*, this would include a material rendering the pouch generally transparent" (emphasis added). However, as noted in MPEP §2112 (citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)):

To establish inherency, the extrinsic evidence "*must make clear* that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, *may not be established by probabilities or possibilities*. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

(emphasis added)

It is clear that the Office action does not "make clear" that the materials of the pouch of the Friedman are "necessarily" transparent. In fact, the Friedman reference does not even tangentially suggest or disclose that any of the material disclosed therein may be transparent. Thus it is submitted that the text of the Friedman reference does not support the interpretation advanced in the Office action.

As noted in paragraph 22 of the pending application, the transparent nature of the pouch allows the top sheet of the stack of sheets to be viewed through the pouch. For example, a shopping list that a user has written on the sheets could be viewed through the empty pouch. This benefit is specifically claimed in claim 28. Thus, the transparent nature of the pouch provides a definite, clearly specified functional advantage that is recited in the original application as well as in the text of claim 28.

In contrast, the Friedman reference does not address any similar advantages that would propose or suggest making the pouch of that reference transparent. Under the reasoning advanced in the Office action, nearly any material property of the pouch would be rendered obvious or anticipated in light of listing of several types of material provided in the Friedman

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reference. Thus it is submitted that the subject matter of claims 13 and 28 is not shown in the Friedman reference, and that the rejections thereto should be withdrawn.


Finally, it is noted that the exact nature of the rejection of claim 28 at issue is not fully understood. At the beginning of paragraph 4 of the final Office action the claims are indicated to be rejected under 35 U.S.C. §103(a). However, with respect to claim 28, the Office action does not appear to rely upon any secondary references, and appears to take the position that the Friedman reference discloses all of the elements of claim 28 (including a transparent pouch) under an anticipation standard. This is supported by the fact that the Office action relies upon a showing of the transparent nature of the pouch under alleged inherency.

However, if claim 28 were in fact to be rejected under an anticipation standard, it is noted that the Friedman reference clearly does not disclose the subject matter of claim 28, even when any inherent disclosures of that references are considered. Alternately, if the final Office action is in fact making an obviousness rejection of claim 28, it is noted that the Office action fails to produce a secondary reference which discloses a transparent pouch, a motivation to combine the references, etc. Thus, it is submitted that the rejection of claim 28 is improper under either an anticipation standard or an obviousness standard.

Accordingly, it is submitted that the application is now in a condition for allowance and a formal notice thereof is respectfully solicited.

The Commissioner is hereby authorized to charge any additional fees required, including the fee for an extension of time, or to credit any overpayment to Deposit Account 20-0809. The applicant(s) hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,



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